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D E C I S I O N
of 17 December 2004

Case Number: T 0958/04 - 3.2.6

Application Number: 98920334.4

Publication Number: 0907779

IPC: D04H 1/52

Language of the proceedings: EN

Title of invention:

Stitch bonded fabric and fluid-retaining fabric made therewith

Applicant:

Standard Textile Company, Inc.

Opponent:

-

Headword:

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Relevant legal provisions:

EPC Art. 123(2), 111(1)

Keyword:

"Amendments - deletion of features (no)"
"Remittal (yes)"

Decisions cited:

T 0331/87, T 0514/88, T 0187/91, T 0802/92

Catchword:

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Case Number: T 0958/04 - 3.2.6

D E C I S I O N
of the Technical Board of Appeal 3.2.6
of 17 December 2004

Appellant: Standard Textile Company, Inc.
1 Knollcrest Drive
P.O. Box 371805
Cincinnati
Ohio 45222 - 1805 (US)

Representative: Findlay, Alice Rosemary
Lloyd Wise
Commonwealth House
1 - 19 New Oxford Street
London WC1A 1LW (GB)

Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 5 February 2004
refusing European application No. 98920334.4
pursuant to Article 97(1) EPC.

Composition of the Board:

Chairman: G. Pricolo
Members: G. L. de Crignis
J. H. van Moer

Summary of Facts and Submissions

- I. European patent application No. 98 920 334.4 published as international application PCT WO 98/51850 was refused by decision of the Examining Division dated 5 February 2004.

Claim 1 of the applicant's main request on which the decision of the Examining Division is based reads as follows:

"A stitch bonded facing fabric (10) comprising a felt web (12) having an upper surface (20) and a lower surface (22), and a plurality of stitch bonding yarns (18) repeatedly extending through the felt web (12) characterised in that the stitch bonding yarns (18) have yarn segments (18', 18") extending across both the upper and lower surfaces (20, 22) of the felt web (12) such that the yarn segments (18') extending across the felt web upper surface (20) cooperate to form a top yarn face (24) above the felt web upper surface (20) and the yarn segments (18") extending across the felt web lower surface (22) cooperate to form a bottom yarn face (26) below the felt web lower surface (22)."

- II. In the course of the examination proceedings, the Examining Division issued a communication under Rule 51(4) EPC dated 1 June 2001 in which it informed the applicant that it intended to grant a European patent on the basis of the claims of the application as originally filed. With letter dated 6 December 2001 the applicant filed an amended set of claims and requested the grant of a patent on the basis thereof. Following a communication under Rule 96(2) EPC in which claim 1 was

objected to pursuant to Article 123(2) EPC, the applicant requested, as a main request, to grant a patent on the basis of the amended set of claims, or auxiliarily, on the basis of the claims originally filed as proposed for grant by the Examining Division. In a second communication under Rule 51(4) EPC dated 24 February 2003 the Examining Division announced again its intention to grant a patent on the basis of the claims of the application as filed, in accordance with the applicant's auxiliary request, and stated with reference to its previous communication under Rule 96(2) EPC that the main request was not allowable under Article 123(2) EPC. After receipt of the letter dated 21 August 2003 in which the applicant requested the refusal of the application if the main request was not allowed, the Examining Division issued the decision to refuse the application.

III. The appellant (applicant) lodged an appeal against this decision, received at the EPO on 26 March 2004 and simultaneously paid the appeal fee. With the statement setting out the grounds of appeal, received at the EPO on 25 May 2004, the appellant requested that the decision of the Examining Division be set aside and the case be remitted for further examination on the basis of the claims filed as Annex 2, which were identical to the claims of the main request on which the decision of the Examining Division was based, or, as an auxiliary request, that a patent be granted on the basis of the documents in accordance with the communication under Rule 51(4) EPC.

Claim 1 in accordance with this auxiliary request reads as follows:

"A stitch bonded facing fabric (10) comprising a felt web (12) having an upper aspect (14) extending from an upper surface (20) of the web (12) and a lower aspect (16) extending from a lower surface (22) of the web (12), and a plurality of stitch bonding yarns (18) repeatedly extending through the felt web (12) characterised in that the upper aspect (14) is hydrophobic, the lower aspect (16) is hydrophilic, and the stitch bonding yarns have yarn segments (18', 18") extending across both the upper and lower surfaces (20, 22) of the felt web (12) such that the yarn segments (18') extending across the felt web upper surface (20) cooperate to form a top yarn face (24) above the felt web upper surface (20) and the yarn segments (18") extending across the felt web lower surface (22) cooperate to form a bottom yarn face (26) below the felt web lower surface (22)."

IV. With letter dated 14 December 2004, the appellant referred to prior art documents cited against the applicant's US patent 5290269 and filed a copy of document:

D1: US-A-5 085 653

V. During oral proceedings held on 17 December 2004, at the end of which the decision of the Board was announced, the appellant maintained the requests made in the written proceedings.

VI. The appellant's submissions in support of its main request can be summarized as follows.

The omission in claim 1 of the features that the felt web had a hydrophobic upper aspect and a hydrophilic lower aspect did not contravene Article 123(2) EPC but met the criteria set out in T 331/87 and T 802/92 for allowing the removal of a feature from a claim. The omitted features were neither explained as essential in the disclosure nor did they make a technical contribution to the invention. In the discussion of the prior incontinence pads in the application as filed it was stated that it was desirable, and therefore not essential, to provide a fabric with a hydrophobic upper aspect and a hydrophilic lower aspect. Since it was already known to provide these features, it was clear that they could not constitute the invention. Furthermore, the problem underlying the application was to provide a fabric with reduced manufacturing costs. The solution to this problem was to stitch bond a felt web so as to provide top and bottom yarn faces formed by the stitch bonding yarns. For this solution, and in fact also for the intended use of the fabric as a fluid-retaining fabric, it was irrelevant whether or not the upper aspect was hydrophobic and the lower aspect hydrophilic and therefore the omitted features were not indispensable for the function of the invention in the light of the technical problem the invention served to solve. Moreover, the removal of the features did not require any modification of other features to compensate for the change.

The appellant further referred to the criteria set out in decisions T 514/88 and T 187/91 and stated that the

amendments of claim 1 also met those criteria: the amendments were consistent with the original disclosure and the skilled reader of the application as filed would seriously contemplate the use of a fabric without a hydrophobic upper aspect and a hydrophilic lower aspect.

As regards document D1, it was filed as an example of the prior art referred to on page 1 of the application as filed.

Reasons for the Decision

1. The appeal is admissible.
2. *Main request*
 - 2.1 In accordance with the established case law of the boards of appeal, and as set out in particular in decisions T 331/87 (OJ 1991, 022) referred to by the appellant, an amendment of a claim extends beyond the subject-matter of the application as filed if it results in the skilled person being presented with information which is not directly and unambiguously derivable from that previously presented by the application, even when account is taken of matter which is implicit to a person skilled in the art.
 - 2.2 An essential aspect of the fabric in accordance with the application as filed is that it has fluid-retaining properties. This undisputed fact is emphasized by the statement on page 2, line 21, according to which the "present invention provides an improved fluid-retaining

fabric". Contrary to the statement of the appellant that it is irrelevant whether or not the fabric has a lower hydrophilic aspect for the intended use as a fluid-retaining fabric, the application as filed (see page 4, lines 16 to 17) clearly discloses that the fluid retaining-properties are related to the hydrophilic properties of the fluid-absorbing lower portion of the fabric since this is the only portion where the fluids may be retained. In fact, it is generally known that in order to absorb and retain fluid, a fabric must comprise at least one hydrophilic structure.

Claim 1 of the main request omits the presence of a hydrophilic aspect. It thus presents the skilled person with the information that the "improved fluid-retaining fabric" might not be hydrophilic at all which is in contrast with the application as filed and constitutes therefore, new information.

- 2.3 The problem stated in the application as filed (page 2, lines 21 to 23) consists in providing "an improved fluid-retaining fabric such as may be substituted for the facing fabric and felt of the prior incontinent pads and which reduces the costs of manufacture thereof". It is true that the problem can be seen in obtaining a reduction of costs of manufacture, however only in connection with the manufacture of an improved fluid-retaining fabric for use in the facing fabric and felt of the prior incontinent pads. The question arises as to what is meant by such an "improved fluid-retaining fabric".

With regard to known "fluid-retaining" fabrics, the application as filed refers to two different pieces of prior art, namely:

- an incontinent pad consisting of a knit or woven facing fabric layer to which is quilted a felt layer (see page 1, lines 9 and 10) and to
- a fluid-retaining fabric which has further desirable properties consisting of a hydrophobic upper surface and a hydrophilic lower surface (page 2, lines 9 to 15).

Considering that in accordance with the invention (claim 1 and page 2, line 23 to page 3, line 7 and claim 1) as originally filed the fabric is defined by an upper aspect extending from an upper surface of the web and a lower aspect extending from a lower surface of the web whereby the upper aspect is specified as being hydrophobic and the lower aspect is specified as being hydrophilic it is rendered clear that with the expression "improved fluid-retaining fabric" the application refers to the prior art fluid-retaining fabric which consists of a hydrophobic upper surface and a hydrophilic lower surface, (the term aspect implying the meaning of "surface" or "layer") not to the other piece of prior art consisting of a knit or woven facing fabric layer to which is quilted a felt layer.

Both the hydrophilic and the hydrophobic surfaces play a role in such "improved fluid-retaining fabric". In fact, the upper hydrophobic surface contributes to wick fluids away from the topside of the fabric, into the

lower hydrophilic surface where the fluids are retained, so as to maintain as dry a surface as possible thereby providing for better patient comfort (see page 2, lines 7 - 9). Therefore, also the upper hydrophobic aspect represents a feature indispensable for the function of the invention in the light of the technical problem it solves.

Claim 1 of the main request omits the presence of a hydrophobic aspect and thus presents the skilled person with the information that the "improved fluid-retaining fabric" might not be hydrophobic at all which is also in contrast with the application as filed and therefore constitutes, new information.

2.4 Accordingly, since claim 1 presents the skilled person with information which is not directly and unambiguously derivable from that previously presented by the application, it contains subject-matter which extends beyond the content of the application as filed, contrary to the requirements of Article 123(2) EPC.

2.5 Decisions T 802/92, T 514/88 and T 187/91 relied upon by the appellant, confirm the above findings.

According to T 802/92, the removal from a claim of a feature which "does not provide a technical contribution to the subject-matter of the claimed invention" does not contravene Article 123(2) EPC. However, as explained above, the omitted features are essential for the function of the invention and therefore provide such a technical contribution.

T 514/88 states that the relevant question in relation to the question of broadening of claim before grant by abandoning a feature is whether or not the amendment is consistent with the original disclosure. In the present case, the omitted features are disclosed as essential in the description. Their omission from the claims results therefore in an amendment which is not consistent with the original disclosure.

In accordance with T 187/91, a specific example within a generic disclosure forming part of the description of the invention in an application as filed is part of the content of the application as filed for the purpose of Article 123(2) EPC if the skilled reader would seriously contemplate such specific example as a possible practical embodiment of the described invention, having regard to its context in the remainder of the application as filed, and subject to any understanding of the skilled reader to the contrary. Since (see point 2.3 above) the starting point for the invention underlying the application as filed is not the generic disclosure of a prior art fluid-retaining fabric consisting of a knit or woven facing fabric layer to which is quilted a felt layer, but a fluid-retaining fabric having a hydrophobic upper surface and a hydrophilic lower surface, the skilled person would not seriously contemplate abandoning relevant features of this starting point and would not take a step back in the direction of prior art which, for the function of the invention, is clearly presented as less appropriate, in the absence of any indications to the contrary as in the present case.

3. *Auxiliary request*

3.1 As regards the claims of the auxiliary request, i.e. the claims on the basis of which the Examining Division intended to grant a European patent in accordance with the communication under Rule 51(4) EPC dated 24 February 2003, they are identical to the claims of the application as filed and therefore do not give rise to objections under Article 123(2) EPC.

4. *Remittal to the first instance*

The appellant filed the prior art document D1 which was not taken into consideration by the Examining Division.

In view of this new situation, the Board considers it appropriate to remit the case to the Examining Division for further prosecution pursuant to Article 111(1) EPC. It is left to the Examining Division to establish whether the intention notified with the communication under Rule 51(4) EPC remains valid or whether further examination becomes necessary.

Furthermore, the Board observes that the term "aspect" present in the claims does not appear to have a precise meaning in the relevant technical field and that it is used throughout the application apparently only to indicate a "layer" of the fabric. Thus the question might arise as to whether the use of this term in the claims is appropriate having regard to the requirements of Article 84 EPC.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The main request is rejected.
3. The case is remitted to the first instance for further prosecution.

The Registrar:

The Chairman:

M. Patin

G. Pricolo